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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/633,801	08/07/2000	George Hsu	PNI-P417CIP	3013
22877 7590 10/16/2007 FERNANDEZ & ASSOCIATES LLP 1047 EL CAMINO REAL SUITE 201 MENLO PARK, CA 94025			EXAMINER BAYARD, DJENANE M	
			ART UNIT 2141	PAPER NUMBER
			MAIL DATE 10/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/633,801	Applicant(s) HSU, GEORGE	
	Examiner Djenane M. Bayard	Art Unit 2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to amendment filed on 7/30/07 in which claims 19-36 are pending.

Response to Arguments

2. Applicant's arguments have been fully considered but they are not persuasive.

As per claims 19-28

In response to applicant's argument that, "the instant invention requires only one component, the base station, to have internet access. No appliance can communicate", "In Hite's system the devices or appliances, the control are network, the control portal and the master controller are internet enabled, all components have individual communication capability and all components interact and; or can be directed by web pages", Applicant is respectfully reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Hite et al fails to teach a control Unit with a wiring interface portion) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Hite et al was not used to teach claims 29-36.

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Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

As per claims 29-36

In response to applicant's argument that "no sensor or actuator of the instant invention is internet enabled", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Gelvin et al clearly teaches a wireless Integrated Network sensor that provide distributed network and to sensors, controls and processors that are deeply embedded in equipment, facilities, and the environment (See abstract)

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 19, 22-24, 27-28 and 34-36 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 7,213,061 to Hite et al.

a. As per claims 19 and 24, Hite et al teaches an Internet Control system and method. Furthermore, Hite et al teaches an Internet-enabled control system for monitoring and controlling home-automated-systems and appliances at a user's premise, comprising: a base station with Internet connection at the user's premise, the base station in communication with sensing and actuating subsystems at individual ones of the home-automated systems and appliances (See col. 3, lines 1-3); a first Internet-connected server communicating over the Internet with the base station, the first server monitoring the sensing subsystems and providing actuating commands to the actuating subsystems through the base station (See col. 3, lines 21-47) an interactive display at a second Internet-connected server providing a set of services to the user not related to control of the home-automated systems and appliances (See col. 4, lines 1-18); and an interactive control interface presentable on the interactive display by the second server, providing a control interface to the user, enabling the user to access settings, view conditions, and issue commands to the home automated systems and appliances over the Internet to the first server and hence to the base station and the systems and appliances themselves, (See col. 4, lines 19-51)).

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b. As per claims 22 and 27, Hite et al teaches the claimed invention as described above.

Furthermore, Hite et al teaches wherein the interactive interface comprises a window opened in the interactive display provided by the second server, the window providing information fields and input fields for the user to read conditions at and to provide input to the systems and appliances (See col. 3, lines 31-47 and col. 4, lines 42-45).

c. As per claim 23 and 28, Hite et al teaches the claimed invention as described above.

Furthermore, Hite et al teaches a data center comprised one or more server computer in communication with a global network such as the Internet that provide many unrelated services (See col. 4, lines 38-41).

d. As per claim 34, Hite et al teaches an Internet-enabled control system for monitoring and controlling home-automated-systems and appliances at a user's premise, comprising:

a base station with Internet connection at the user's premise, the base station in communication with sensing and actuating subsystems at individual ones of the home-automated systems and appliances (See col. 3, lines 1-3); an Internet-connected server communicating over the Internet with the base station, said server monitoring the sensing subsystems and providing actuating commands to the actuating subsystems through the base station (See col. 3, lines 21-47); an interactive display at the Internet-connected base station providing a set of services to the user related to the control and monitoring of the home-automated systems and appliances (See 3, lines 10-12); and an interactive control interface presentable on the interactive display by said server, providing a control interface to the user, enabling the user to access settings, view conditions,

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and issue commands to the home automated systems and appliances over the Internet to the base station and the systems and appliances themselves (See col. 3, lines 31-48 and col. 4, lines 38-45)

e. As per claim 35, Hite et al teaches the claimed invention as described above.

Furthermore, Hite et al teaches wherein said interactive display is hosted by a second Internet-connected server providing a set of services to the user related to control of the home-automated systems and appliances; and an interactive control interface presentable on the interactive display by the second server, providing a control interface to the user, enabling the user to access settings, view conditions, and issue commands to the home automated systems and appliances over the Internet to the first server and hence to the base station and the systems and appliances themselves (See col. 3, lines 31-48 and col. 4, lines 10-51).

f. As per claim 36, Hite et al teaches the claimed invention as described above.

Furthermore, Hite et al teaches interactive display is hosted at a second Internet-connected server providing a set of services to the user unrelated to control of the home-automated systems and appliances; and an interactive control interface presentable on the interactive display by the second server, providing a control interface to the user, enabling the user to access settings, view conditions, and issue commands to the home automated systems and appliances over the Internet to the first server and hence to the base station and the systems and appliances themselves (See col. 3, lines 31-48 and col. 4, lines 38-45)

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5. Claims 29-33 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6, 826607 to Gelvin et al.

a. As per claim 29, Gelvin et al teaches an internet-enabled control system for monitoring and controlling home-automated-systems and appliances at a user's premise, comprising: a base station comprising a microcontroller, memory portion, communication port, and a RF communicating section (See col. 10, lines 24-29, col. 11, lines 6-19, col. 14, lines 58-67); a first internet-connected server communicating with the base station; at least one control unit comprising a microcontroller, an input-output section, a memory portion, a wiring interface portion and a RF communicating section (See col. 10, lines 46-60); at least one actuator; and at least one sensor; wherein the base station receives control code and data via the communication port and communicates via the RF section to the at least one control unit such that each control unit actuates at least one actuator and senses at least one sensor in order that the home automated systems and appliances are controlled in a preset manner by the received control code and data.(See col. 3, lines 33-46, col. 6, lines 43-50 and col. 10, lines 46-60).

b. As per claim 30, Gelvin et al teaches the claimed invention as described above. Furthermore, Gelvin et al teaches an interactive display in communication with said base station providing a set of services via said first server to said user to control said home-automated systems and appliances wherein said server monitors each control unit and provides actuating commands to each control unit through the base station (See col. 3, lines 33-46, col. 6, lines 43-50 col. 10, lines 46-60 and col. 18, lines 46-60).

c. As per claim 31, Gelvin et al teaches the claimed invention as described above.

Furthermore, Gelvin et al teaches an interactive control interface presentable on the interactive display by said first server, providing a control interface to said user, enabling said user to access settings, view conditions, and issue commands via said base station RF communicating section to each said control unit (See col. 11, lines 6-18, col. 14, lines 58-67).

d. As per claim 32, Gelvin et al teaches the claimed invention as described above.

Furthermore, Gelvin et al teaches wherein said interactive interface further comprises a window opened in the interactive display wherein access to additional services comprising at least one of banking services, search services, security exchange services, purchasing services, repair services or personal data aggregation services is provided (See col. 6, lines 38-50).

e. As per claim 33, Gelvin et al teaches the claimed invention as described above.

Furthermore, Gelvin et al teaches access to a second server wherein the second server provides access to at least one of said additional services (See col. 10).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 20-21 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,213,061 to Hite et al in view of U.S. Patent No. 6,192,282 to Smith et al.

a. As per claim 20 and 25, Hite et al teaches the claimed invention as described above.

However, Hite et al fails to teach wherein the authentication technique comprises a password.

Smith et al teaches wherein the authentication technique comprises a password (See col. 35 and 36).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the teaching of Smith et al in the claimed invention of Hite et al in order to provide security to the system.

b. As per claims 21 and 26, Hite et al teaches the claimed invention as described above.

However, Hite et al fails to teach wherein the authentication technique is by prearrangement with the second server verifying the identity of the user or the Internet appliance controlled by the use.

Smith et al teaches wherein the authentication technique is by prearrangement with the second server verifying the identity of the user or the Internet appliance controlled by the use (See col. 35 and 36).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the teaching of Smith et al in the claimed invention of Hite et al in order to provide security to the system.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Djenane M. Bayard whose telephone number is (571) 272-3878. The examiner can normally be reached on Monday- Friday 5:30 AM- 3:00 PM..


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Djenane Bayard

Patent Examiner


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